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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,111	12/14/2001	William R. Matz	36968/265388 (BS01372)	6465

7590 12/19/2005  
SCOTT P. ZIMMERMAN PLLC  
P.O.BOX 3822  
CARY, NC 27519

EXAMINER
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ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/017,111

**Applicant(s)**

MATZ ET AL.

**Examiner**

Raquel Alvarez

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-15 and 18-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-15 and 18-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/26/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed on 10/11/2005.
2. Claims 1-4, 6-15 and 18-38 are presented for examination.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-15 and 18-38 are rejected under 35 U.S.C. 103(a) as being unpatentable by Knudson et al. (WO 99/45702 hereinafter Knudson).

With respect to claims 1-3, 7, 9, 12, 15, 19, 21, 30-32, 34 Knudson teaches a method for marketing (Abstract). Defining a match between a user classification and an incentive (i.e. matching user's interest to advertisements)(page 14, lines 14-31); Receiving from a set-top box user data associated with a user's cable television viewing selections (see Figure 1, item 48); receiving the user's purchase records (i.e. the system receives data related to user's purchases of pay programs)(page 9, lines 5-9); classifying the user in a user classification when the user's cable television viewing selections relate to the user's purchase records (i.e. based on the user's programs viewed and the programs purchased by the user, the system targets advertisements to the user)(page 10, lines 5-21; page 11, lines 22-32; page 14, lines 14-31 and page 19, lines 20 to page 20, lines 1-8 and Figure 16).

With respect to purchase record being made with a credit card describing purchases from retail stores and classifying the user according to purchases from the retail stores. Knudson teaches receiving data related to programs ordered/purchased by the users and classifying the users according to their purchases (page 9, lines 5-9 and page 10, lines 8-11). Knudson is silent as to if the purchases records are for people that have purchased with credit cards and that the purchases are for purchases from retail stores. Official notice is taken that is old and well known that credit cards are old an well known method used to make purchases in order to provide a convenient method to buy merchandises on credit and to also monitor purchases made at retail establishments in order to keep track of what the customers are purchasing at the different establishments. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the purchase records to have been credit card purchases and to monitor purchases from retail stores because such a modification would allow to better target the customers based on if they have credit and to keep track of the purchases made at retail stores in order to better target the customer based on how they pay for the purchases and the retail establishments that they purchase from.

With respect to claim 4, Knudson further teaches that the user's television viewing selection comprises how much of an advertisement the user views (page 27, lines 29 to page 32, lines 1-10).

With respect to claims 6, 8, 18 and 20, Knudson further teaches further classifying the user based on the user's television viewing selections if the user views advertisements for a product and purchases the product (see Figure 24).

Claims 10, 22 further recites that the user data comprises survey data. Official notice is taken that is old and well known in marketing to ask consumers questions about their likes and dislikes and to record the answers to those questions in order to better target the users based on their answers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included survey data in order to obtain the above mentioned advantage.

With respect to claims 11 and 23, Knudson further teaches that the user data comprises a price paid for the product and the time the product was purchased (Figure 8).

Claims 13 and 27 further recites that the incentive comprises a coupon. Knudson teaches providing advertisements. Knudson doesn't necessarily teach that the advertisements are in the form of a coupon. Official notice is taken that is old and well known in marketing to provide coupons to the customers because such a modification would further motivate the customers to make a purchase by providing a discount. It would have been obvious to a person of ordinary skill in the art at the time

of Applicant's invention to have included the incentive to be in the form of a coupon in order to obtain the above mentioned advantage.

With respect to claims 14 and 26, Knudson further teaches that the incentive comprises a banner (See Figure 8, item 124).

With respect to claims 24-25, 28, 29, Knudson further teaches that the incentive comprises an image embedded into cable television media content, video program (page 14, lines 3-7).

Claim 33 further recites transmitting the incentive to the user by mail. Official notice is taking that it is old and well known to provide incentives to the user by mail. For example, advertisements are old and well known to be sent to the users by mail in order to cast a large group of people. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the incentive to the user by mail in order to obtain the above mentioned advantage.

Claim 35 further recites receiving records related to a shopping card in which the user is given a discount in exchange for using the shopping card. Official notice is taken that it is old and well known in marketing to give incentives or discount to the user to motive them to use a preferred method of payment or the like. For example, Macy's will give a discount to the customers if they make purchases with their Macy's card. It

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would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving records related to a shopping card in which the user is given a discount in exchange for using the shopping card in order to obtain the above mentioned advantage.

Claims 36-37 further recite receiving a separate identification codes identifying each user of a common user terminal. Official notice is taken that it old and well known to use codes or passwords to identify each user of a common terminal. For example, Microsoft XP interface allows each user of a common terminal to enter a password in order to identify each of the user of the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving a separate identification codes identifying each user of a common user terminal in order to distinguish one user from the other user of the same terminal.

Claim 38 further recites that the incentive comprises a redeemable coupon. Knudson teaches providing advertisements. Knudson doesn't necessarily teach that the advertisements are in the form of a redeemable electronic coupon. Official notice is taken that is old and well known in computer related arts to provide redeemable electronic coupons to the customers because such a modification would further motivate the customers to make a purchase by providing a redeemable electronic coupon. It would have been obvious to a person of ordinary skill in the art at the time of

Applicant's invention to have included the incentive to be in the form of a redeemable electronic coupon in order to obtain the above mentioned advantage.

**Response to Arguments**

4. Applicant argues that Knudson doesn't teach receiving the user's credit card purchase records describing purchases from retail stores and classifying the users based on the user's television viewing selections and purchases from retail stores. The Examiner respectfully disagree with Applicant. Knudson teaches classifying users according to user's viewing selections and purchases of pay-per view programs on ("e.g. , **pay program account information or information regarding programs that have been purchased and viewed .....**) page 10, lines 8-11. The only substantial difference between Knudson and Applicant's invention is that in applicant's invention the purchases are made via a retail store. The Examiner has taken official notice that monitoring purchases made at retail establishments is old and well known in order to keep track of what the customers are purchasing at the different establishments. The purchases made through a retail store is not a patentable difference . The Examiner wants to point out that In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references or to knowledge of one of ordinary skilled in the art at the time of Applicant's invention. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).



**Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

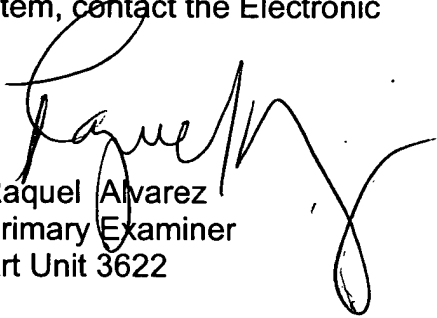
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
12/13/2005